

inserting an automatic back up device into a port of a computer;
the computer scanning and detecting the automatic backup device connected to the port;
the computer identifying the automatic backup device;
the computer then automatically launching a backup procedure to backup its files onto the automatic backup device; and
the computer automatically closing down the backup procedure at the completion of the backup of the computer files onto the automatic backup device.

REMARKS

New claims 41-58 are in the application, Claims 21-40 having been cancelled without prejudice. All the new claims are virtually identical to canceled Claims 21-40 except as set forth below. Claims 26 and 27 were not carried over to the new claims. With respect to Claim 41, the term "then automatically" has been added to the fifth line of Claim 21 to create claim 41. Claims 42-57 are identical to Claims 22-25 and 28-39, except for dependency which had to be renumbered. The dependency of all the new claims remains identical to the dependency of the canceled claims, except for new claim 49 [31] which has been made dependent upon new claim 48 [30]. Canceled claim 31 was incorrectly made dependent upon claim 21; it should have been dependent upon claim 30. With regard to new claim 58, this claim is identical to Claim 40, except that on the sixth line of new claim 58, the term " then" has been added before the term "automatically."

The amendment to the claims is fully supported by the specification as filed. See, for example, page 4, lines 14-22 et seq. The claims were amended to further meet a requirement made by the Examiner. The amended claims add no new matter to the application.

THE OFFICE ACTION

On page 2, paragraph 3, of the Action, the Examiner contends that the "...limitation of automatically launching the backup operation by insertion alone of the backup device is not reflected in the claim language. Claims 21 [41] and 40 [58] merely require a computer to launch its automatic backup procedure once it recognizes that the automatic backup system (ABS) is inserted into the PCMCIA port. Claims 21 and 40 do not exclude scheduled automatic backup." The applicant traverses this allegation because Claims 21 and 40 clearly specified that the computer upon recognizing the ABS unit inserted into its PCMCIA port, launched its automatic backup procedure which comprised the steps set forth in Claims 21 and 40.

To advance prosecution of this application, Applicant has amended Claims 21 and 40 into new Claims 41 and 58, respectively, to further emphasize that the computer **then automatically** launches its automatic backup procedure when a ABS unit has been inserted in a port and the computer recognizes the ABS unit inserted into its PCMCIA port or other port. This language clearly excludes scheduled automatic backup. The computer automatically launches, it does not wait for a scheduled date or time as Makinen teaches.

The Action on pages 2 and 3 further states that "Makinen explicitly shows a method of automatically backing up data from a computer (see the abstract). Although Makinen does not specifically show that the automatic backup system (ABS) is connected to the PCMCIA port of the computer, it is well known in the art as shown by Harari to connect peripheral cards to the PCMCIA port on a computer for backup purposes (see column 3, lines 20-23, column 9, lines 18-30). Therefore, it would have been obvious to one of ordinary skill in the art to include connecting an ABS unit to the PCMCIA port while implementing the method taught by Makinen in order to use a standard port of the computer to attach peripheral cards for automatic backup of data as taught by Makinen."

Makinen does not teach the automatic backup system of the present invention. Makinen states in the abstract, "A system and method for automatically archiving data from a computer system to a backup system. **The system provides a scheduler, connected to an automated backup mechanism for scheduling when full backups are performed and when incremental backups are performed.**" (emphasizes added) Nowhere within Makinen is it taught that backup can be accomplished or should be accomplished without a scheduler or a scheduling step. In addition, neither Makinen or Harari teach that the backup should commence upon insertion and recognition of the backup device in the port. The teaching of Makinen is clear: the backup does not commence until the scheduled day and the time requirements are met. There is no scheduling step in Claims 41-58.

35 USC § 103 Rejection

Claims 21-40 are rejected under 35 USC 103(a) as being unpatentable over Makinen et al. (US 5,758,067) of record, in view of Harari et al. (US 5,887,145). With regard to Claim 21, the Action alleges that "Makinen discloses a method of automatically backing up data from a computer, (see the abstract). Although Makinen does not specifically show that the automatic backup system (ABS) is connected to the PCMCIA port of the computer, it is well known in the art as shown by Harari to connect peripheral cards to the PCMCIA port on a computer for backup purposes (column 3, lines 20-23, and column 9, lines 18-30). Therefore it would have been obvious to one of ordinary skill in the art to include connecting an ABS unit to the PCMCIA port while implementing the method taught by Makinen in order to use a standard port of the computer to attach peripheral cards for automatic backup data as taught by Makinen. Furthermore, it would have been obvious to one of ordinary skill in the art to include all the claimed operations of scanning for devices connected to the PCMCIA port, recognizing the ABS unit inserted to the PCMCIA port, launching the automatic backup procedure, scanning all source files and comparing

to the files on the ABS for changes, determining space required for backing up data and space available on the ABS, making a file-by-file transfer of the changes to the ABS unit if space is available on the ABS since the computer has to recognize the presence of the ABS before launching the automatic backup and only files that have changed need be backed up again on the ABS, provided space is available on the ABS.

No authority or evidence is cited to show the above recited steps or the combinations. But more significantly, the art does not show that upon "the computer recognizing the ABS unit inserted into its PCMCIA port, the computer then automatically launching its automatic backup procedure..." (Claim 41, lines 4 and 5). These steps are not taught or suggested by Makinen and Harari. Any combination of Makinen or Harari does not realize these steps. Even hindsight reconstruction of the references will not yield these steps because these key steps of the claims are completely missing from the references.

With regard to Claims 22-39 which were ultimately dependent upon Claim 21, the Office Action contends that it would have been obvious to one of ordinary skill in the art to carry out the recited step of each claim. No authority or evidence was presented to show the recited step is known or to show that it would have been obvious to combine the recited step with Claim 21. The applicant traverses the rejection of Claims 22-25 and 28-39 as they are applied to identical new Claims 42-57.

In the case of *In re Lee* (61 USPQ 2d 1430). Decided on January 18, 2002, the U.S. Court of Appeals for the Federal Circuit, took up the issue whether claims can be properly rejected on conclusions of the basic knowledge or common sense of one of ordinary skilled in the art. The Court quoted from *In re Fritch* that " '...the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious' (citation omitted)" 61 USPQ2d 1434. The court also quoted from *In re Zurko* that " 'deficiencies of the cited references cannot be remedied by the Board's general

conclusions about what is basic knowledge or common sense.' (citation omitted)" at 1434-44. Thus the court fully rejected the "basic knowledge" or "commonsense" type of rejection where there is no evidence supporting such basic knowledge or commonsense. The court required that evidence and authority be shown to support that the combination and missing element of a rejected claim are obvious to one of ordinary skill. The cited prior art does not teach the steps nor the combinations set forth in Claims 22-39. Since there is no evidence or authority for the steps and combination of these claims, the rejection of Claims 22-39 is clearly unsupported and improper.

Similarly, the rejection to Claim 40 does not meet the standards set forth in the *In re Lee* case. It is admitted in the Action that Makinen does not specifically show that the system performs all the claimed operations of Claim 40. But the Action states that "it is well known in the art to connect a backup system to a computer as shown by Harari (page reference omitted). The Action then concludes that it would have been obvious to one of ordinary skill in the art to include all the claimed operations of scanning and detecting a device connected to a port of the computer, identifying the automatic backup system, automatically launching a backup procedure while implementing the system of Makinen in order to backup file changes to a system connected to the computer through a port depending on the size of the backup data as taught by Harari to avoid operator's intervention. Furthermore, since the backup system is inserted to a port of the computer, it would have been obvious to one of ordinary skill in the art to make the computer automatically close the backup procedure once the backup had been completed in order to disconnect the backup system from the computer system."

No authority or evidence is cited to show the above-mentioned steps or combination. In addition a significant deficiency is the fact that neither reference teaches or suggests commencing backup by insertion of the backup device and recognition of the device in a port by the computer. As shown above these steps are not taught by the references, and there is not evidence or

authority to show that these steps would have been obvious to one of ordinary skill. The rejection of Claim 40 is clearly unsupported and improper under the dictates of the In re Lee case.

DRAWING

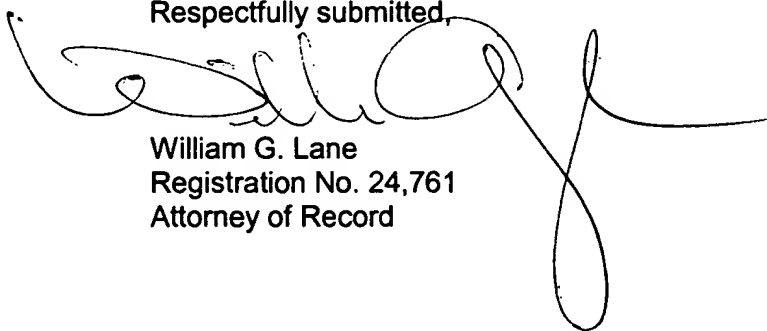
A proposed amended drawing has been prepared (copy attached) and has been submitted to the chief draftsman for review and approval.

CONCLUSION

In conclusion, it is respectfully submitted that the new claims 41-58 are clearly patentable over Makinen and Harari, either alone or in combination. It would not have been obvious to one of ordinary skilled in the art to take the backup system of Makinen and modify it so that backup was initiated on the insertion of a backup unit into a computer because these steps are not taught, suggested, even hinted at, in either Makinen or Harari.

A favorably action is solicited.

Respectfully submitted,



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